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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,382	12/09/2003	Zhiyun Chen	2476-36	2845

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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT PAPER NUMBER

1756

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,382

Applicant(s)

CHEN ET AL.

Examiner

Martin J. Angebrannt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a reversible photo-bleachable materials of semiconductor particles, classified in class 252, subclass 600.
 - II. Claim 7 and 17-29 and 32-33, drawn to a methods of using a reversible photo-bleachable materials to recording images with a spot size below the diffraction limit, classified in class 430, subclass 269.
 - III. Claims 8-16, drawn to controlling the relaxation time of a reversible photo-bleachable layer by changing functionalizing the surface, classified in class 427, subclass 384.
 - IV. Claims 17-29 and 32-33, drawn to a methods of exposing a resist to pattern it with a reversible photo-bleachable layer coated upon it, classified in class 430, subclass 273.1.
 - V. Claims 30 and 31, drawn to a method of inspecting a photomask bearing a reversible photo-bleachable layer coated upon it, classified in class 430, subclass 322.
 - VI. Claims 34-35, drawn to a reversible photo-bleachable materials layer on a recorded optical recording medium, classified in class 430, subclass 270.11.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions group I and group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP

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§806.05(h). In the instant case the CEL materials can be coated on a ROM optical recording medium, so no images are created, but only readout is modified.

4. Inventions group I and group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP§ 806.05(f)). In the instant case the CLE materials may be used alone without modification or functionalization of the surface.

5. Inventions group I and group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP§ 806.05(h). In the instant case the CEL materials can be coated on a ROM optical recording medium, so no images are created, but only readout is modified or can be coated on the photomask.

6. Inventions group I and group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP §806.05(h). In the instant case the CEL materials can be coated on a ROM optical recording medium, so no images are created, but only readout is modified or can be coated on the resist.

7. Groups I and VI are related and would be examined together.

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8. Inventions group II and group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation.

9. Inventions group II and IV are directed to related inventions.

See election of species below

10. Inventions group II and group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation.

11. Inventions group II and group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation.

12. Inventions group III and group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation.

13. Inventions group III and group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation.

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14. Inventions group III and group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation.

15. Inventions group IV and group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation. The location of the CEL layer is different.

16. Inventions group IV and group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation. The CEL is either over a resist or atop a optical disk information layer.

17. Inventions group V and group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP§ 802.01 and§ 806.06). In the instant case, the different inventions the processes cannot be used together and have different modes of operation. The CEL is either over a mask image or atop a optical disk information layer.

18. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification and because of

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their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

19. This application contains claims directed to the following patentably distinct species: group II recites a resolution, group IV recites the type if imaging layer it is atop. Also the structure of group V could be used for imaging.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 7 is the most generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP§ 809.02(a).

NB: claims 28 and 29 are directed to the system. This appears to be in error as they are dependent upon method claims. If this is not the case, then the applicant should make them a separate group and the system would be examined with groups I and VI.

20. A telephone call was made to Robert Feris on August 18, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

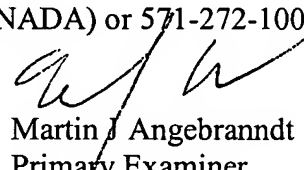
21. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Martin J Angebranndt
Primary Examiner
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8/18/2006